

DOCKET NO.: NNI-0005
Application No.: 10/672,833
Office Action Dated: November 14, 2008

PATENT

Amendments to the Drawings

The attached sheet includes changes to Figure 1. The sheet, which includes Figure 1, replaces the original Figure 1.

Attachment: Replacement Sheet

REMARKS

Claims 1-21, 23, 24, 26-30, 35-51, 53-63 and 66-69 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pub. No. 2003/0050527 to Fox *et al.* (“Fox”). In particular, the office action suggests that Fox’s paragraph [0150] teaches a circuit pad with a conductor that reduces stimulation caused by a separate magnetic stimulation device. With all due respect to the contentions in the office action, applicants respectfully disagree.

The claimed embodiments are directed to a circuit pad that reduces discomfort caused by a magnetic stimulation device. The circuit pad includes a conductor that reduces the stimulation from the magnetic stimulation device. The circuit pad with the conductor are located peripheral to the magnetic stimulation device. The magnetic stimulation device creates magnetic fields to treat a patient’s depression, for example, while the peripheral and separate conductor on the circuit pad reduces undesirable and painful stimulation of the patient’s scalp stimulation, for example.

The office action suggests that Fox’s paragraph [0150] teaches the circuit pad with the conductor, as recited in the claimed embodiments. In particular, the office action suggests that Fox’s “negative turns *in the windings of the stimulator coil*” may reduce stimulation. (*Office Action dated November 14, 2008 at p. 10*) (emphasis added). However, as the office action itself acknowledges, Fox’s “conductor” or negative winding is not located peripheral to, and apart from, Fox’s coil-based magnetic stimulation device. Instead, Fox’s “conductor” *is part of the stimulator coil itself*.

Fox’s paragraph [0150] notes that it reduces stimulation using “the addition of negative turns to the windings of the stimulator coil, and a small spacing between the coil and the scalp.” In other words, Fox’s coil is generating the magnetic field, and Fox simply adds more windings to this coil to alter its field. While the claimed embodiments recite a circuit pad with a conductor separate from the magnetic stimulation device, Fox teaches a conductor that is part of the device that generates the magnetic field.

The distinction of having a separate conductor proximate to the magnetic stimulation device is significant. In fact, Fox’s paragraph [0150] admits that its technique has an impact on the coil generating the field itself when it acknowledges that its technique “comes at the expense of some focusing ability, and coil inductance and heating.”

Accordingly, applicant respectfully requests withdrawal of the rejection of claims 1-21, 23, 24, 26-30, 35-51, 53-63 and 66-69 under 35 U.S.C. 102(e) over Fox.

Claims 22 and 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fox in view of U.S. Pub. No. 2001/0018547 to Mechlenburg *et al.* (“Mechlenburg”). Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Fox. Claims 31-34, 52 and 64-65 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fox in view of U.S. Patent No. 6,477,410 to Henley *et al.* (“Henley”).

For the same reasons discussed above with respect to the rejection of claims 1-21, 23, 24, 26-30, 35-51, 53-63 and 66-69 under 35 U.S.C. 102(e) over Fox, applicant respectfully requests withdrawal of the rejection of claims 22 and 63 over Fox and Mechlenburg, claim 25 over Fox, and claims 31-34, 52 and 64-65 over Fox and Henley.

Finally, claims 7-19 and 54-60 stand rejected under 35 U.S.C. 112, first paragraph, allegedly as failing to comply with the enablement requirement. In particular, the office action suggests that the “disposal mechanism . . . was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” (*Office Action dated November 14, 2008 at pp. 2-3*). Similarly, the drawings are objected to under 37 CFR 1.83(a) for not showing the disposal mechanism. The office action contends that “there is no physical structure assigned to the mechanism.” (*Office Action dated November 14, 2008 at p. 9*) (emphasis added).

Although applicants note that the claimed disposal mechanism does not necessarily require a “physical structure” that would be apparent in the Figures, applicant has amended Figure 1 and the specification to include a “disposal mechanism 110.” While applicant previously has noted that the disposal mechanism may be a part of the flexible circuit pad, applicant has amended the specification and Figure 1 in an effort to facilitate prosecution.

As previously noted, the disposal mechanism is described in detail in the specification, and particularly at paragraph [0034] of the present specification. In particular, the present specification, as amended, describes that “[f]lexible circuit pad 106 also may include electrical or physical disposal mechanisms 110 that require a new flexible circuit pad to be used with each treatment.” (*Specification* – paragraph [0034]). The present specification also notes an alternative “disposal mechanism 110 [that] may allow a certain flexible circuit pad a certain number of times and/or be used by a certain patient.” (*Id.*). One

of the stated purposes of such a disposal mechanism may be to “prohibit undesirable re-usage of the flexible circuit pad 106, and therefore facilitate sanitary usage of flexible circuit pad 106 both for an individual patient and across numerous patients.” (*Id.*).

Applicant submits that the amended description is sufficient for one of ordinary skill in the art to make and/or use a disposal mechanism on the novel device. Applicants also note that the addition of piece number 110 is for clarity only and does not constitute new matter.

Accordingly, applicant respectfully requests withdrawal of claims 7-19 and 54-60 under 35 U.S.C. 112, first paragraph, as well as the objection to the drawings under 37 CFR 1.83(a).

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Conclusion

In view of the foregoing, applicant respectfully submits that the claims are allowable and that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Vincent J. Roccia at (215) 564-8946, to discuss resolution of any remaining issues.

Date: April 9, 2009

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